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MAILED
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OFFICE OF PETITIONS

In re Application of :
Fralick, Breiter, Peterson, : DECISION REFUSING STATUS
Gilbert, Distel, Newman, and : UNDER 37 CFR 1.47(a)
Erickson :
Application Number: 10/782733 :
Filing Date: 02/19/2004 :
Title of Invention: BIO-
PHOTONIC FEEDBACK CONTROL
SOFTWARE AND DATABASE

This is a corrected decision in response to the petition under 37 CFR 1.47(a) filed on July 16, 2004.

The Office apologizes for the delay in responding to the subject petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on February 19, 2004, without an executed oath or declaration. Accordingly, on May 13, 2004, the Office of Patent Application Processing mailed a Notice to File Missing Parts of Nonprovisional Application requiring the statutory basic filing fee, an executed declaration, a surcharge for their late filing, and additional claim fees.

In response, on July 16, 2004 (certificate of mailing date July 13, 2004), the present petition was filed, along with the surcharge, statutory basic filing fee, petition fee, and a declaration naming John Fralick, David L. Breiter, Jack Peterson, Mindy Gilbert, Marvin Distel, Ryan Newman, and Joel Erickson as joint inventors, signed by all inventors except joint inventor Distel on behalf of themselves and non-signing inventor Distel.

Petitioners assert that non-signing inventor Distel "affirmatively declined to sign the required documents" in the subject application.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventors.

The petition lacks item (1), (2), and (5).

Petitioners have not shown that a copy of the application as filed (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventor.¹

MPEP 409.03(c)(II) states that a refusal by an inventor to sign and oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors for review by

¹ MPEP 409.03(d).

providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners **must** show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

With regards to item (2) the declaration is defective in that it does not state the citizenship the inventors.² A statement of the inventors' citizenship is a statutory requirement and cannot be waived.³ Furthermore, the residence city and state or city and foreign country for each inventor is missing.

MPEP 605.02 states that applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with 37 CFR 1.63 unless it is included in an application data sheet (37 CFR 1.76).

It is additionally noted that the residence and mailing address for non-signing inventor Distel are missing from the declaration. Applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with 37 CFR 1.63 unless it is included in an application data sheet (37 CFR 1.76).⁴

Each applicant's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. Applicant's mailing address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the mailing address. The mailing address should include the ZIP Code designation. Since the term "post office address" as

² MPEP 605.01.

³ 35 U.S.C. § 115, MPEP 605.01.

⁴ MPEP 605.02

previously used in 37 CFR 1.63 may be confusing, effective November 7, 2000, 37 CFR 1.63 was amended to use the term "mailing address" instead.

The object of requiring each applicant's mailing address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.⁵

Petitioners are reminded that any oath or declaration filed with a renewed petition must identify both the application number and filing date of the application. The new oath or declaration must be signed by all of the signing inventors on behalf of themselves and the non-signing inventor, and include each inventor's residence, mailing address, and citizenship.

With regard to item (5), an application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor. That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor. Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.⁶

Receipt of the petition fee is acknowledged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300

⁵ MPEP 605.03

⁶ MPEP 409.03(e).

Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

A reply may also be filed via EFS-Web.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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